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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,766	01/19/2000	Veronique Mahe	ROC-17	8806

7590 10/30/2006

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EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/483,766	Applicant(s) MAHE ET AL.	
	Examiner Blessing M. Fubara	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-37 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 35-37 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of request for extension of time, request for reconsideration and remarks filed 8/10/06. No claim is currently amended. Claims 35-37 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 35-37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over by Koga (JP 10, 231,238).

Koga in JP 10,231,238 teaches a cosmetic composition that is prepared by adding 0.001-10.0 weight percent of menthol and at least one of menthyl lactate, menthyl glycoside menthyl hydroxybutyrate, menthoxypropanediol and menthoxyfurane (abstract). In the instant claims the ratio of menthol to menthyl lactate is in the range of from about 1/3 to about 1/10 and the amounts of menthol at from about 0.01% to about 2% by weight and menthyl lactate from about 0.1% to about 10% in the composition would satisfy the ratio. In the prior art, because amounts of menthol and menthyl lactate lie within and overlap the recited range, a certain composition of the prior art would have the recited ratio of menthol to menthyl lactate. Specifically, Koga's Examples 1, 4, 10 and 16 are compositions containing menthol and menthyl lactate, glycerol,

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ethanol and isopropyl alcohol and the ratio of the menthol to methyl is 1:1 for Example 4, 2:1 for Example 1 and 3:1 for Examples 10 and 16 (see pages 4 and 5 of the translation). Paragraph [0005] of the translation talks about “refreshing feeling.” Paragraph [0011] of the translation discloses applying the cosmetic composition to the face.

Koga discloses a composition containing menthol and menthyl lactate. Glycerol and ethanol are carriers. The claimed method uses the menthol formulation as a shower gel and as a foaming gel for the face. A shower gel or foaming facial gel must contain at least a gelling agent and the applicants’ shower gel contains surfactant, hydroxypropyl methylcellulose, preservative and fragrances in addition to the menthol and menthyl lactate. Koga does not state that the cosmetic is used as a shower gel. However, shower gel or facial gel is a form of cosmetics. Regarding the menthol/methyl ratio of 1:3 to about 1:10, it is noted that there is no demonstration that the recited menthol/menthyl ratio provides unexpected results.

The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). In the instant case, the composition Koga has the same basic and novel characteristic of cleansing and freshening the skin.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare and apply the composition of Koga to the face or skin. One having ordinary skill in the art would have been motivated to use the composition of Koga in shower gel with the expectation that the shower gel will provide similar/same sustained refreshing feel as when applied to the face.

Response to Arguments

3. Applicant's arguments filed 8/10/06 have been fully considered but they are not persuasive.

Applicant argues that a) Koga achieves “refreshing” results by using refrigerants such as menthol and menthyl lactate and that these refrigerants are not necessarily used together and not necessarily in the ratios recited in the claims; Koga does not disclose the claimed ratio of menthol to menthyl lactate, i.e. 1:3 to 1:10 for the claims and 2:1 or 3:1 for Koga, which provides lower concentration for the lactate than for the claims;

b) Koga requires that the refrigerants be used with ethanol and isopropyl alcohol;

c) Koga does not recognize that menthol and menthyl lactate may be combined to produce refreshment without annoying or irritating sensitive skin;

d) While Koga may contain the same ingredients as in the claims, the amounts are different and Koga does not disclose simultaneous cleaning and refreshing of the skin; Koga does not suggest doing the refreshing and/or cleaning without irritation.

Response:

a) These refrigerants are the same as are recited and Koga specifically contemplates that the cosmetic composition would provide sustained refreshing feeling (paragraph [0005]). Koga desires the amount of the refrigerants to range from 0.001:10% and more preferably, from 0.01 to 5% (paragraph [0006]). Specific examples of Koga disclose ratios of menthol: menthyl lactate at 1:1, 2:1, 3:1 (Tables 1-4, Examples 21, 22 and 24). While the ratios of menthol to methyl lactate differ from the claimed ratio, the ratio of 1:1 is closest to 1:3. The disclosed

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range in amounts of the refrigerant and Koga's disclosure that there is no particular limitation in the amount of the refrigerant, and further that the use of menthyl lactate is most desirable (paragraphs [0005] and [0006]) implies that the amounts of the refrigerants may be optimized to provide desired level of freshness. However, in the absence of factual evidence showing unexpected result of a 1:3 menthol:menthyl lactate over a 1:1 menthol:menthyl lactate of the prior art, a 1:3 ratio as claimed is not inventive over the ratio of the prior art. Koga achieves the same effect of refreshing feeling as in the claims. The composition is applied to the skin and cleaning may accompany refreshing feeling.

b) Ethanol and isopropyl alcohol do not materially affect the novel characteristics of the menthol and the menthyl lactate.

c) and d) Koga desires for the composition to have refreshing effect on the skin and does not disclose that the composition is annoying or irritating to the skin. Applicant suggests that the same ingredients as is in the claims may be present in the composition of the prior art, and thus it would be obvious that cleansing would accompany refreshing when the composition is applied to the skin.

The rejection on record is a made under 35 USC 103 (a) and not under 102 (b).

No claim is allowed.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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